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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/509,806   | 10/28/2004  | Bernhard Meyer       | 1981USWO            | 8347             |
| 43896  | 7590        | 10/04/2006           | [REDACTED]          | EXAMINER         |
| ECOLAB INC.<br>MAIL STOP ESC-F7, 655 LONE OAK DRIVE<br>EAGAN, MN 55121 |             |                      | DELCOTTO, GREGORY R |                  |
|  |             |                      | [REDACTED]          | ART UNIT         |
|  |             |                      |                     | PAPER NUMBER     |
|  |             |                      | 1751                |                  |

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/509,806             | MEYER ET AL.        |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Gregory R. Del Cotto   | 1751                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 July 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 10-26 is/are pending in the application.
- 4a) Of the above claim(s) 10-16 and 25 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 17-24 and 26 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Claims 1-9 are canceled. Claims 10-26 are pending. Applicant's amendments and arguments filed 7/24/06 have been entered.

Applicant's election of Group I, claims 17-24 in the reply filed on 7/24/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 10-16 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/24/06.

#### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

#### **Objections/Rejections Withdrawn**

The following objections/rejections as set forth in the Office action mailed 5/25/06 have been withdrawn:

The objection to claims 21 and 22 has been withdrawn.

The rejection of claims 17, 19-21, 23, and 24 under 35 U.S.C. 103(a) as being unpatentable over Lang et al (US 5,858,945) has been withdrawn.

The rejection of claims 17 and 19-24 under 35 U.S.C. 103(a) as being unpatentable over MacBeath (US 5,747,438) has been withdrawn.

The rejection of claims 17-24 under 35 U.S.C. 103(a) as being unpatentable over EP 1,064,845 in view of Lang et al (US 5,858,945) has been withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 17-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO98/25468 (Biering et al (US 6,540,960)) in view of Lang et al (US 5,858,945).

Note that, Biering et al is a 371 application of WO98/25468 and has been used as a translation of '468 since, according to PCT rules, the 371 application and PCT application must be identical.

Biering et al teach a process for disinfecting medical instruments involving reacting a hydrogen peroxide donor with an N-acyl compound in an aqueous medium having a pH of 9 to 11 to form an acylated hydrogen peroxide preparation. The process is effective against mycobacteria. See Abstract. Preferably, the composition is in powder form which is then dissolved in water and added to the substrate intended to be cleaned and disinfected. See column 4, lines 40-69. The powdered composition contains from 5 to 40% by weight of a solid inorganic percompound, from 5 to 30% of TAED, from 20 to 50% of sodium tripophosphate, 0 to 15% of surfactant, and the balance to 100% of other auxiliaries. See column 5, lines 1-30. Suitable surfactants include nonionic and anionic surfactants and suitable nonionic surfactants include alcohols alkoxylated with ethylene oxide and a small quantity of propylene oxide. See column 4, lines 1-25.

Biering et al do not teach the use of the specific EO/PO surfactant or a method of disinfecting a surface using a composition which generates peracetic acid containing a peroxide, an acylating agent, specific nonionic surfactant, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Lang et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific EO/PO surfactant in the composition taught by

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Biering et al, with a reasonable expectation of success, because Lang et al teach the use of the specific EO/PO surfactants in a similar hard surface cleaning composition composition and further, Biering et al teach the use of nonionic surfactants having ethylene oxide and propylene oxide groups in general.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to disinfect a surface using a composition which generates peracetic acid containing a peroxide, an acylating agent, specific nonionic surfactant, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Biering et al in combination with Lang et al suggest a method of disinfecting a surface using a composition which generates peracetic acid containing a peroxide, an acylating agent, specific nonionic surfactant, and the other requisite components of the composition in the specific amounts as recited by the instant claims. Additionally, the Examiner asserts that the teachings of Biering et al in combination with Lang et al would suggest compositions having the same disinfectant properties as recited by the instant claims because Biering et al in combination with Lang et al teach compositions containing the same components in the same proportions as recited by the instant claims.

Claims 17-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO01/47565 (Biering et al (US 6,908,891)) in view of Lang et al (US 5,858,945).

Note that, Biering et al is a 371 application of WO01/47565 and has been used as a translation of '565 since, according to PCT rules, the 371 application and PCT application must be identical.

Biering et al teach the use of agents, which contain at least one disinfection system based on selected organic peracids and combinations of peracids, in automatically functioning systems, in which fragile medical appliances, in particular, endoscopes, are cleaned and disinfected. See Abstract. The disinfecting system contains organic peracids, at least one fatty acid, at least one hydrotrope, at least one surfactant and/or at least one complexing component. See column 4, line 30 to column 5, line 15. Additionally, the hydrogen peroxide may be reacted with a N-carboxylic acid amide such as N-acylcaprolactam or TAED to generate the peracetic acid. See column 5, lines 1-60. Suitable surfactants include alkoxylated alky alcohols containing 8 to 22 carbon atoms wherein the alkoxy component is mixed ethoxylated or propoxylates. See column 7, lines 1-50.

Note that, with respect to claim 17, this claim is a process claim which contains a product-by-process limitation within the process claim that does not further limit the process and has not been read as a claim limitation; specifically, the product-by process limitation is forming a peracetic acid use solution by dissolving a powder in water wherein the powder contains certain bleaching constituents. Note that, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is

the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP 2113. The Examiner maintains that Biering et al teach a process of cleaning/disinfecting medical instruments by using a peracetic acid use composition as recited by the instant claims.

Biering et al do not teach the use of the specific EO/PO surfactant or a method of disinfecting a surface using a composition which generates peracetic acid containing a peroxide, an acylating agent, specific nonionic surfactant, and the other requisite components of the composition in the specific amounts as recited by the instant claims.

Lang et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific EO/PO surfactant in the composition taught by Biering et al, with a reasonable expectation of success, because Lang et al teach the use of the specific EO/PO surfactants in a similar hard surface cleaning composition and further, Biering et al teach the use of nonionic surfactants having ethylene oxide and propylene oxide groups in general.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to disinfect a surface using a composition which generates peracetic acid containing a peroxide, an acylating agent, specific nonionic surfactant, and the other requisite components of the composition in the specific amounts as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Biering et al in combination with Lang et al suggest a method of disinfecting a surface

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using a composition which generates peracetic acid containing a peroxide, an acylating agent, specific nonionic surfactant, and the other requisite components of the composition in the specific amounts as recited by the instant claims. Additionally, the Examiner asserts that the teachings of Biering et al in combination with Lang et al would suggest compositions having the same disinfectant properties as recited by the instant claims because Biering et al in combination with Lang et al teach compositions containing the same components in the same proportions as recited by the instant claims.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 17-24 and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,540,960 in view of Lang et al (US 5,858,945).

Claims 1-21 of US 6,540,960 encompass all the material limitations of the instant claims except for the inclusion of the specific EO/PO surfactant in addition to the other requisite components of the composition as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific EO/PO surfactant in the composition taught by claimed by '960, with a reasonable expectation of success, because Lang et al teach the use of the specific EO/PO surfactants in a similar hard surface cleaning composition and further, '960 claims the use of surfactants in general.

Claims 17-24 and 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,908,891 in view of Lang et al (US 5,858,945).

Claims 1-20 of US Pat. 6,908,891 encompass all the material limitations of the instant claims except for the inclusion of the specific EO/PO surfactant in addition to the other requisite components of the composition as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific EO/PO surfactant in the composition taught by claimed by '891, with a reasonable expectation of success, because Lang et al teach the use of the specific EO/PO surfactants in a similar hard surface cleaning composition and further, '891 claims the use of surfactants in general.

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Claims 17-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/945816 in view of Lang et al (US 5,858,945).

Claims 1-21 of 10/945816 encompass all the material limitations of the instant claims except for the inclusion of the specific EO/PO surfactant in addition to the other requisite components of the composition as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific EO/PO surfactant in the composition taught by claimed by '816, with a reasonable expectation of success, because Lang et al teach the use of the specific EO/PO surfactants in a similar hard surface cleaning composition and further, '816 claims the use of surfactants in general.

This is a provisional obviousness-type double patenting rejection.

#### ***Response to Arguments***

With respect to the rejection of the instant claims under 35 USC 103(a) under Biering et al in combination with Lang et al, Applicant states that the present invention is distinguished from Lang et al. In response, note that, Lang et al is a secondary reference relied upon for its teaching of a particular nonionic surfactants. The Examiner maintains that one of ordinary skill in the art clearly would have been motivated to use the nonionic surfactants as taught by Lang et al in the cleaning compositions taught by Biering et al, with a reasonable expectation of success, because Lang et al teach the use of the specific EO/PO surfactants in a similar hard surface

cleaning composition composition and further, Biering et al teach the use of nonionic surfactants having ethylene oxide and propylene oxide groups in general.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory R. Del Cotto  
Primary Examiner  
Art Unit 1751

GRD  
October 2, 2006